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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,270	12/20/2000	Michael Gargiulo	NC25580	2797

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,270

Applicant(s)

GARGIULO ET AL.

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 7-10 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5-7.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. Claims 1-10 are pending in this application.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-6, drawn to remote downloading multimedia data, classified in class 709, subclass 203.
 - II. Claims 7-10, drawn to data structure, classified in class 707, subclass 102.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as remote downloading and accounting for a media content over a communication system, lacking one or more of the particulars of inventions II. Invention II has separate utility such as data structure comprising different field as different indicators, lacking one or more of the particulars of inventions I. See MPEP § 806.05 (d).
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. A telephone call was made to applicant's Attorney on June 25, 2004 to request an oral election to the above restriction requirement, resulted in an election being made to Invention I, presented by claims 1-6 without traverse.

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6. Applicant is advised that the reply to this requirement to be complete must include confirmation to the election of the invention to be examined is the response to this office action.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Claims 1-7 are now are pending in this application.

9. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A (1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

10. The disclosure is objected to because of the following informalities: The disclosure refer in page 3 (and may be in other locations) to Appendix A, which does not exist.

Appropriate correction is required.

11. The disclosure is objected to because it contains, in almost all the Poages, an embedded hyperlink and/or other form of browser-executable code. Applicant is required to

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delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

a) "the permanent memory", claim 2, line 10; claim 3, line 12; claim 4, line 9; and claim 5, line 11.

b) "the tangible medium", claim 6, line 1. Accordingly, claim 6 is not been further treated on the merits.

B. The use of the following phrases render the claim vague or unclear:

a) "and the like", claim 6, line 2. The phrase "or the like" renders the claim indefinite because the claim includes elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

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14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payne et al. (US 5,909,492), hereafter, Payne.

16. As to claim 1, Payne discloses the invention substantially as claimed including a method for accounting for media content sent over a communication system (abstract) comprising the steps of: requesting media content by sending message with a header comprising a first identification number (col. 5, lines 17-23,47-49); receiving a message which comprises the media content, a reply Universal Resource Locator (URL) identifying a server, and a transaction identification (col. 5, lines 49-51); saving the media in a temporary memory (shopping cart database 21, Fig. 1); sending a primitive with the identification information to the server identified by the URL (col. 5, lines 53-56, 57-62); saving the media in a permanent memory only when permission to save has been received (finalizing the purchase).

17. Payne does not necessarily disclose saving the media content in temporary memory and then to a permanent memory before and after the permission taken for the payment computer. However, It would have been obvious to one skilled in the art at the time of the invention to consider Payne's disclosure of a shopping cart that store temporarily the selected media content (products) until it is actually purchased after approval from the payment computer.

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18. As to claim 2, the claim is rejected for the same reasons as claim 1 above. In addition Payne discloses, in a server coupled to a network, a method of accounting for media content comprising the steps of: providing a device on the network with a plurality of media choices (buyer computer 12, Fig. 1 and col. 5, lines 20-22); receiving a selection from the plurality of media choices from the device (col. 5, lines 26-27); generating a database record, a transaction number, and an URL (col. 5, lines 29-43); sending a message to the device, said message comprising the URL and the media content (col. 5, lines 49-51), wherein the device is required to send a primitive to the URL before the media content may be saved to the permanent memory of the device (col. 5, lines 53-56, 57-62).

19. As to claim 3, the claim is rejected for the same reasons as claims 1- 2 above. In addition, a computer-readable memory for directing a computer to function in a particular manner when used by the computer, comprising: a first portion to direct the computer to provide a device with a plurality of media choices; a second portion to direct computer to receive a selection from the plurality of media choices from the device; a third portion to direct computer to generate a database record; a fourth portion to direct computer to generate a transaction number; a fifth portion to direct computer to generate an URL; and a sixth portion to direct a computer to send message comprising the URL and the media to the device, wherein the device is required to send a primitive to the URL before the media content may be saved to the permanent memory of the device is inherent in Payne's disclosure..

20. As to claim 4, the claim is rejected for the same reasons as claims 1-3 above. In addition, a computer data signal embodied in a carrier wave, comprising instructions for: providing a device on the network with a plurality of media choices; receiving a selection from

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the plurality of media choices from the device; generating a database record; generating a transaction number; generating an URL; sending a message to the device, said message comprising the URL and the media content, wherein the device is required to send a primitive to the URL before the media content may be saved to -the permanent memory of the device is inherent in Payne's disclosure.

21. As to claim 5, the claim is rejected for the same reasons as claims 1-4 above. In addition, a computer program product that enables a network entity to account for media content comprising: computer readable code that instructs computer to: provide a device on with a plurality of media choices; receive a selection from the plurality of media choices from the device; generate a database record; generate a transaction number; generate an URL; and send message comprising the URL and the media to the device, wherein the device is required to send a primitive to the URL before the media content may be saved to the permanent memory of the device; and a tangible medium that stores the computer readable code is inherent in Payne's disclosure.

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fuller et al. (US 6,216,112); Spaur et al. (US 2002/0013167); Merriman et al. (US 5,948,061); Hartman et al. (US 5,960,411); Park (US 6,058,375); Katz et al. (US 2002/0059363); Shah-Nazaroff et al. (US 6,157,377); and Bartoli et al. (6,047,268).

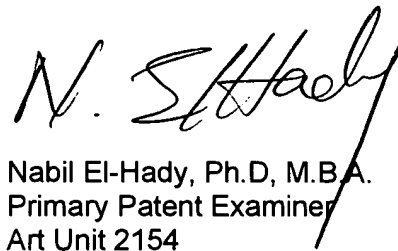
23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 24, 2004


Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
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